

Remarks

Reconsideration of this Application is respectfully requested. Upon entry of the foregoing amendment, claims 1-37 and 41-53 are pending in the application, with 1, 24, and 41 being the independent claims. Claims 38-40 are cancelled. Claims 1, 24, and 41 are amended to clarify the invention. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Amendment of claims 1, 24, and 41 does not add new matter, further clarifies the claims, and improves readability. This amendment is supported by the specification at least in Figures 1 and 2, as well as in paragraphs [0007]-[0008], [0039] - [0040], [0047] - [0049], [0052] - [0053], and [0057]. Applicants respectfully request the amendment be entered by the Examiner. Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Rejections under 35 U.S.C. § 103

On page 3 of the Office Action, claims 1, 13-18, 23-24, and 35-37 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. 2003/0048781 to Pierson (herein "Pierson") in view of U.S. Patent No. 6,438,717 to Butler *et al* (herein "Butler"). Applicants traverse this rejection and respectfully request this rejection be removed and these claims be passed to allowance.

Claim 1 has been amended so that *the packet transmit circuit and the packet receive circuit are both deposited on a common substrate.* (See, claim 1) Claim 24 has been similarly amended.

Applicants respectfully submit that neither Pierson nor Butler, alone or in combination, teach, suggest, or disclose all elements of amended independent claims 1 and 24. More specifically, Applicants respectfully submit that neither Pierson nor Butler, alone or in combination, teach, suggest, or disclose, "said packet transmit circuit and said packet receive circuit are deposited on said substrate" as recited in amended independent claims 1 and 24. Specifically, an integrated packet bit error rate tester having *both a packet transmit circuit and a packet receive circuit deposited on a common substrate* is not found in either Pierson or Butler, therefore the *prima facie* requirements for obviousness are not satisfied by their combination. (*See*, MPEP 2143)

The Office Action appears to rely on Butler for the *mentioned packet transmit circuit and packet receive circuit*. (*See*, Office Action, para 7) Referring to FIG. 1 of Butler, the transmitting ASIC 1 is separate and distinct from the receiving ASIC 2. (*See*, Butler, FIG. 1). Pierson does not cure this deficiency.

Therefore, because neither Pierson nor Butler, alone or in combination, teach, suggest, or disclose all elements of amended independent claims 1 and 24, a *prima facie* case of obviousness has not been established. Furthermore, dependent claims 13-18, 23, and 35-37, which depend upon their respective independent claims 1 and 24 are allowable for at least being dependent from an allowable independent claim, in addition to their own respective patentable features. Accordingly, Applicants respectfully request this rejection be removed and that these claims be passed to allowance.

On page 5 of the Office Action, claims 2-3 and 29-30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Pierson in view of Butler, further in view of U.S. Patent No. 6,140,956 to Hillman *et al* (herein "Hillman"). Applicants traverse this

rejection and respectfully request this rejection be removed and these claims be passed to allowance.

Dependent claims 2-3 and 29-30 depend from their respective independent claims 1 and 24. Hillman does not cure the deficiencies mentioned above for Pierson in view of Butler. Accordingly, claims 2-3 and 29-30 are allowable for at least being dependent from an allowable independent claim, in addition to their own respective features. Accordingly, Applicants respectfully request this rejection be removed and that these claims be passed to allowance.

On page 6 of the Office Action, claims 4-5, 19-22, and 25-28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Pierson in view of Butler, and further in view of U.S. Patent Publication No. 2002/0054569 to Morikawa *et al* (herein "Morikawa"). Applicants traverse this rejection and respectfully request this rejection be removed and these claims be passed to allowance.

Dependent claims 4-5, 19-22, and 25-28, which depend upon their respective independent claims 1 and 24, are allowable for at least being dependent from an allowable independent claim, in addition to their own respective features. Morikawa does not cure the deficiencies of Pierson in view of Butler. Accordingly, Applicants respectfully request this rejection be removed and that these claims be passed to allowance.

On page 8 of the Office Action, claims 6-7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Pierson in view of Butler, further in view of U.S. Patent No. 5,726,991 to Chen *et al* (herein "Chen"). Applicants traverse this rejection

and respectfully request this rejection be removed and these claims be passed to allowance.

Dependent claims 6-7, which depend upon independent claim 1, are allowable for at least being dependent from an allowable independent claim, in addition to their own respective features. Chen does not cure the deficiencies of Pierson in view of Butler. Accordingly, Applicants respectfully request this rejection be removed and that these claims be passed to allowance.

On page 9 of the Office Action, claim 8 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Pierson in view of Butler, further in view of U.S. Patent Publication No. 2001/0012288 to Yu *et al* (herein "Yu"). Applicants traverse this rejection and respectfully request this rejection be removed and this claim be passed to allowance.

Dependent claim 8, which depends upon independent claim 1, is allowable for at least being dependent from an allowable independent claim, in addition to its own respective features. Yu does not cure the deficiencies of Pierson in view of Butler. Accordingly, Applicants respectfully request this rejection be removed and that this claim be passed to allowance.

On page 10 of the Office Action, claims 9-12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Pierson in view of Butler, further in view of U.S. Patent Publication No. 2003/0009307 to Mejia *et al* (herein "Mejia"). Applicants traverse this rejection and respectfully request this rejection be removed and these claims be passed to allowance.

Dependent claims 9-12, which depend upon independent claim 1, are allowable for at least being dependent from an allowable independent claim, in addition to their own respective features. Mejia does not cure the deficiencies of Pierson in view of Butler. Accordingly, Applicants respectfully request this rejection be removed and that these claims be passed to allowance.

On page 11 of the Office Action, claims 31-34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Pierson in view of Butler, Hillman, and Mejia. Applicants traverse this rejection and respectfully request this rejection be removed and these claims be passed to allowance.

Dependent claims 31-34, which depend upon independent claim 24, are allowable for at least being dependent from an allowable independent claim, in addition to their own respective features. Mejia and Hillman do not cure the deficiencies of Pierson in view of Butler. Accordingly, Applicants respectfully request this rejection be removed and that these claims be passed to allowance.

On page 12 of the Office Action, claims 41-42, 44, and 51 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Pierson in view of Butler, further in view of U.S. Patent No. 6,081,570 to Ghuman *et al* (herein "Ghuman"). Applicants traverse this rejection and respectfully request this rejection be removed and these claims be passed to allowance.

Applicants respectfully submit that neither Pierson, Butler, nor Ghuman, alone or in combination, teach, suggest, or disclose all elements of amended independent claim 41. Applicants respectfully submit that neither Pierson, Butler, nor Ghuman, alone or in combination, teach, suggest, or disclose, "a transmitter memory deposited on a substrate

and . . . a receiver deposited on the substrate" as recited in amended independent claim 41. (Emphasis added). Specifically, a circuit having both a transmitter memory and a receiver deposited on a common substrate is not found in Pierson, Butler, or Ghuman. Therefore, the *prima facie* requirements for obviousness are not satisfied by their combination

Therefore, because neither Pierson, Butler, nor Ghuman, alone or in combination, teach, suggest, or disclose all elements of amended independent claim 41, a *prima facie* case of obviousness has not been established. Therefore the *prima facie* requirements for obviousness are not satisfied by their combination.

Therefore, because neither Pierson, Butler, nor Ghuman, alone or in combination, teach, suggest, or disclose all elements of amended independent claim 41, a *prima facie* case of obviousness has not been established. Furthermore, dependent claims 42, 44, and 51, which depend upon independent claim 41, are allowable for at least being dependent from an allowable independent claim, in addition to their own respective features. Accordingly, Applicants respectfully request this rejection be removed and that these claims be passed to allowance.

On page 14 of the Office Action, claims 43 and 45 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Pierson in view of Butler, Ghuman, and Hillman. Applicants traverse this rejection and respectfully request this rejection be removed and these claims be passed to allowance.

Dependent claims 43 and 45, which depend upon independent claim 41, are allowable for at least being dependent from an allowable independent claim, in addition to their own respective features. Hillman does not cure the deficiencies of Pierson in

view of Butler and Ghuman. Accordingly, Applicants respectfully request this rejection be removed and that these claims be passed to allowance.

On page 14 of the Office Action, claims 46-47 and 52-53 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Pierson in view of Butler, Ghuman, and Morikawa. Applicants traverse this rejection and respectfully request this rejection be removed and these claims be passed to allowance.

Dependent claims 46-47 and 52-53, which depend upon independent claim 41, are allowable for at least being dependent from an allowable independent claim, in addition to their own respective features. Morikawa does not cure the deficiencies of Pierson in view of Butler and Ghuman. Accordingly, Applicants respectfully request this rejection be removed and that these claims be passed to allowance.

On page 16 of the Office Action, claims 48-49 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Pierson in view of Butler, Ghuman, and Chen. Applicants traverse this rejection and respectfully request this rejection be removed and these claims be passed to allowance.

Dependent claims 48-49, which depend upon independent claim 41, are allowable for at least being dependent from an allowable independent claim, in addition to their own respective features. Chen does not cure the deficiencies of Pierson in view of Butler and Ghuman. Accordingly, Applicants respectfully request this rejection be removed and that these claims be passed to allowance.

On page 16 of the Office Action, claim 50 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Pierson in view of Butler, Ghuman, and Yu.

Applicants traverse this rejection and respectfully request this rejection be removed and this claim be passed to allowance.

Dependent claim 50, which depends upon independent claim 41, is allowable for at least being dependent from an allowable independent claim, in addition to its own respective features. Yu does not cure the deficiencies of Pierson in view of Butler and Ghuman. Accordingly, Applicants respectfully request this rejection be removed and that this claim be passed to allowance.

Other Matters

The Office Action Summary indicates that claims 38-40 are withdrawn from consideration. Claims 38-40 were cancelled in Applicants' reply filed July 7, 2006.

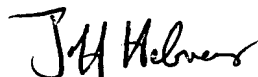
Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Jeffrey T. Helvey
Attorney for Applicants
Registration No. 44,757

Date: 3/5/07

1100 New York Avenue, N.W.
Washington, D.C. 20005-3934
(202) 371-2600

598695_1.DOC